

**IN THE CLAIMS:**

Please amend the following claims:

24. A transgenic plant having introduced into its genome the nucleic acid of claim 15.

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**REMARKS**

Claims 15-24 are pending in this case. A copy of the changes made to the claims can be found on the page marked "Version with Markings to Show Changes." An appendix with the claims as pending is attached for the Examiner's convenience.

Restriction Requirement:

The Examiner requires restriction as between Invention I, claims 15-23, and Invention II, claim 24. Applicants elect Group I, claims 15-23, classified in class 536, subclass 23.72. The election is made with traverse. For the following reasons, reconsideration of the Examiner's restriction requirement is respectfully requested.

Claims 15 is directed to an isolated nucleic acid molecule comprising a first sequence encoding at least one capsid protein of an insect small RNA virus and a second sequence which is insecticidal or which encodes an insecticidal protein toxin. Claims 16-23 depend from claims 15. Amended claim 24 is directed to a transgenic plant comprising the nucleic acid of claim 15. Applicants therefore respectfully submit that the concurrent examination of the claims of Group I and II would not place an undue burden on the Examiner as the claim of Group II comprises, utilize, or apply the isolated nucleic acid molecules of the claims of Group I.

Furthermore, Applicants note that during the examination of Serial No. 08/485,355, of

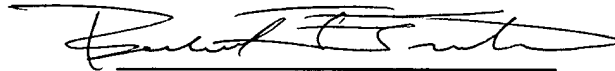
Serial No. 09/677,653

which the present application is a divisional, the Examining Attorney found that pending Claims 15-24 were a distinct invention classified in Class 800, subclass 205. *See*, Paper 11, mailed January 7, 1997, attached. Applicants therefore respectfully request withdrawal of the additional restriction requirement.

Respectfully submitted,

FLEHR, HOHBACH, TEST,  
ALBRITTON & HERBERT

Date: 2/28/02



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Serial No. 09/677,653

**Version with Markings to Show Changes**

24. A transgenic plant [resistant to insect attack comprising a] having introduced into its genome [or subgenome capable of expressing] the nucleic acid [molecule as claimed in] of claim 15 [such that the transgenic plant produces capsid protein in which is encapsidated the nucleic acid molecule].

**Appendix - Pending Claims**

15. An isolated nucleic acid molecule comprising a first sequence encoding at least one capsid protein of an insect small RNA virus and a second sequence which is insecticidal or which encodes an insecticidal protein toxin.
16. An isolated nucleic acid molecule as claimed in claim 15 in which the nucleic acid is RNA.
17. An isolated nucleic acid molecule as claimed in claim 15 in which the insect small RNA virus is HaSV.
18. An isolated nucleic acid molecule as claimed in claim 15 in which the capsid protein is P71 (SEQ ID No. 50)
19. An isolated nucleic acid molecule as claimed in claim 15 in which the insecticidal toxin is of plant origin.
20. An isolated nucleic acid molecule as claimed in claim 15 in which the insecticidal toxin is Ricin A.
21. An isolated nucleic acid molecule as claimed in claim 15 in which the second sequence is an antisense sequence, a ribozyme or a mimicking structure.
22. An isolated nucleic acid molecule as claimed in claim 21 in which the mimicking structure is double stranded RNA.
23. An isolated nucleic acid molecule as claimed in claim 15 in which the insecticidal toxin is less toxic to plants than insects.
24. (Amended) A transgenic plant having introduced into its genome the nucleic acid of claim 15.

File A-58631-2 Att'y WHD

Due Date 97-02-06

Type 30 DAY Re's 30 DAY



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/485,355	06/07/95	CHRISTIAN	P A-58631-2/WH
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EXAMINER

ART UNIT PAPER NUMBER

11

RECEIVED

DATE MAILED:

MAR 14 2002

01/07/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

TECH CENTER 1600/2900

☒ This application has been examined *for restriction purposes only* ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____   |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1-32 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☐ Claims \_\_\_\_\_ are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☒ Claims 1-32 are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1803.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

5 I. Claims 1-14, drawn to a capsvector, classified in Class 435, subclass 320.1, for example.

II. Claims 15-24, drawn to a DNA construct comprising a first and second sequence and plants transformed therewith, classified in Class 800, subclass 205, for example.

10 III. Claims 25-32, drawn to a DNA construct comprising a first, second and third sequence and plants transformed therewith, classified in Class 435, subclass 172.3, for example.

The inventions are distinct, each from the other because of the following reasons:

15 The inventions of Groups I-III are distinct one from the other, wherein each is not required by either of the others. The capsvector of Group I is not required by the constructs or transformed plants of either of Groups II or III, and the constructs and transformed plants of Groups II and III are not required by the capsvectors of Group I. In addition, the constructs and transformed plants of Group II are not required by the constructs and transformed plants of Group III, and the constructs and transformed plants of Group III are not required by the constructs and transformed plants of Group II. The capsvector of

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Group I and the constructs of Groups II and III differ in structure and are capable of being independently made, separately used and the patentability of one does not render either of the others obvious or unpatentable.

5           Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, their recognized divergent subject matter and the requirement for different areas of search restriction for examination purposes as indicated is proper.

10           Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

15           Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-1794. The examiner can normally be reached on Tuesday through Friday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Mondays.

20           If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Robinson, can be reached at (703) 308-2897. The fax phone number for this Group is (703) 308-4227. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

25           Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

January 3, 1997

**ELIZABETH MCELWAIN**  
**PATENT EXAMINER**  
**GROUP 1800**

*Elizabeth F. McElwain*